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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/396,523	09/15/1999	NICOLAAS M. J. VERMEULIN	275102221021	7553

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EXAMINER
O SULLIVAN, PETER G

ART UNIT	PAPER NUMBER
1621	12

DATE MAILED: 03/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant
09/396,523	Vermeulen et al.
Examiner	**Art Unit**
Peter O'Sullivan	1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Dec 13, 2001* .

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *3 and 30-48* is/are pending in the application.

4a) Of the above, claim(s) *32 and 35-48* is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *3, 30, 31, 33, and 34* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s): *5, 7, 1*

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

1. Claims 3 and 30-48 are pending in this application which should be reviewed for errors. In response to the requirement for the election of a single disclosed species, applicants have elected compound 1158 with traverse. Applicants' elected species is allowable and the search has been extended to those compounds where R is alkyl or RC(O) is valine or lysine. Claims 32 and 35-48 are held withdrawn as not embracing the elected species and/or because they contained non-examined species and are not currently under rejection. References not initialed on applicants' form 1449's were not available to the examiner and applicants are requested to send copies with their next response.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 3 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for compounds of the scope of claim 3 as amended in paper No. 8, does not reasonably provide enablement for applicants' claims where R is a mono-substituent. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. Compounds, for example, with phosphinylnonacontanyl moieties would not receive adequate support in the specification.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 3 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Gunthorpe et al. (Toxicon, Vol. 28, No. 11) who disclose anticipating acylspermines in table 7.

6. Claims 3, 33 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Cherksey et al., (WO 91/00853) who disclose lysylspermine on page 19.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 3, 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gunthorpe et al. who disclose anticipating compounds noted above to be useful as glutamate

receptor antagonists and differs from the teaching of the instant invention in that homologues/positions isomers thereof are claimed by applicants. It would have been prima facie obvious at the time the invention was made to start with the teaching of the cited reference to make positions isomers/homologues thereof and to expect them to be useful as glutamate receptor antagonists. In re Mills, 126 USPQ 513.

9. Claims 3, 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cherksey et al. who disclose the anticipating compound noted above to be useful as P channel activator and differs from the teaching of the instant invention in that homologues/positions isomers thereof are claimed by applicants. It would have been prima facie obvious at the time the invention was made to start with the teaching of the cited reference to make positions isomers/homologues thereof and to expect them to be useful as P channel activators. In re Mills, 126 USPQ 513.

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 3, 30, 31, 33 and 34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 09/713,512. Although the conflicting claims are not identical, they are not patentably distinct from each other because they generically overlap.

12.. No claim is allowed.

13. Any inquiry concerning this communication should be directed to Peter O'Sullivan at telephone number (703) 308-4526.

PETER O'SULLIVAN
PRIMARY EXAMINER
GROUP 1200